

**REMARKS****I. Status of the Claims**

Claims 1-35, 50, 51, and 54-159 are currently pending. Of these, claims 1, 19, 20, 35, 50, 51, 54, 69, 70, 85, 86, 101, 102, 117, 118, 132, 133, and 147-157 are independent. By this Amendment, claims 19, 62, 94 and 110 have been amended. Applicants believe that these changes introduce no new matter. Entry and consideration of this Amendment are respectfully requested.

**II. Objections to the Specification**

Claim 110 recites the limitation "odd driving device" in line 3. The Examiner states that this term lacks antecedent basis. Applicants amended claim 100, changing "odd" to --the--. Applicants respectfully request that this objection be withdrawn.

**III. Rejections under 35 U.S.C. §112**

Claims 19, 62, 94, and 126 are rejected under 35 U.S.C. §112, second paragraph as being allegedly indefinite. Applicants request that these rejections be withdrawn for at least the following reasons.

With respect to claim 19, the phrase "in an external control state in which said camera is not controlled by an external controller" has been changed to --in an external control state in which said camera is not controlled by an external controller--.

Claims 62, 94, and 126 state "the determination device causes said driving device to move the image sensing optical system to the non image sensing." The Examiner asserts that the phrase "non image sensing" is unclear. To overcome this rejection, Applicants amended claims

62 and 94 to recite "non image sensing" to --non image sensing region. However, Applicants assert that claim 126 is proper in its current form.

#### **IV. Rejections under 35 U.S.C. §103**

Claims 1-3, 15-22, 33-35, 50-51, 54-57, 62, 68-70, 72, 83-87, 89, 94, 100-102, 104, 115-120, 126, 131-133, and 145-159 are rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over U.S. Patent No. 6,256,063 to Saito et al. ("Saito") in view of U.S. Patent No. 5,136,320 to Kobayashi et al. ("Kobayashi"). Applicants respectfully traverse this rejection.

The independent claims in this application recite features involving the judgment of a setting. For instance, the image sensing apparatus of claim 1 recites a determination device that judges at least whether an image sensing apparatus is in an external control state in which the apparatus is controlled by an external controller unit or the apparatus is in an image sensing state in which the apparatus is not controlled by the external controller unit. In addition, the independent claims recite features involving determining an operation of a driving device based on the setting.

Saito involves a camera that can connect to a host computer through a card interface. At column 9, line 63 through column 10, line 10, Saito discloses various control operations of performed by the host computer on the camera. However, as expressed by the Examiner on page 4 of the Office Action, Saito does not disclose a device that moves an image sensing optical system to image sensing and non-image sensing regions.

Kobayashi involves an electronically controlled camera having a motor for moving a lens. However, Kobayashi neither discloses nor suggests an external controller that may control the lens. Therefore, the combination of Saito and Kobayashi fails to suggest the invention of the

independent claims because these references do not disclose a driving device as recited in the independent claims that is externally controlled.

The Examiner applies additional references to make the following rejections of various dependent claims under 35 U.S.C. §103:

1. Claims 4-6, 10, 11, 23-25, 27-29, 58-60, 63, 64, 74-76, 78-80, 90-92, 95, 96, 106-108, 110-112, 121-123, 127, 136-138, and 140-142 are rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Saito in view of Kobayashi, and further in view of U.S. Patent No. 5,210,567 to Takahashi ("Takahashi");
2. Claims 7-8, 12-14, 26, 30-32, 56, 61, 65-67, 77, 81-83, 88, 93, 97-99, 109, 113-115, 125, 124, 128-130, 139, and 143-145 are rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Saito in view of Kobayashi, and further in view of U.S. Patent No. 5,136,320 to Hashimoto et al. ("Hashimoto"); and
3. Claim 9 is rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Saito in view of Kobayashi, and further in view of U.S. Patent Application Publication No. 2003/0030729 to Prentice et al. ("Prentice").

However, these additional references do not appear to overcome the aforementioned shortcomings of Saito and Kobayashi. Therefore, Applicants request that these rejections be withdrawn for at least the reasons set forth above.

### **CONCLUSION**

Based on the foregoing amendments and remarks, Applicants respectfully request reconsideration and withdrawal of the rejection of claims and allowance of this application.

**AUTHORIZATION**

The Commissioner is hereby authorized to charge any additional fees which may be required for consideration of this Amendment to Deposit Account No. 13-4500, Order No. 1232-4522.

In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 13-4500, Order No. 1232-4522.

Respectfully submitted,  
MORGAN & FINNEGAN, L.L.P.

Dated: \_\_\_\_\_

12/10/04

By: \_\_\_\_\_



John A. Harroun  
Registration No. 46,339  
(202) 857-7887 Telephone  
(202) 857-7929 Facsimile

**Correspondence Address:**

MORGAN & FINNEGAN, L.L.P.  
3 World Financial Center  
New York, NY 10281-2101